

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). MPEP §2142. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Claims 13, 14, 15 and 16 specifically require glass or plastic as forming the transparent portion of the front panel. These claims stand rejected under 35 U.S.C. §103(a) as being obvious over *Young* in view of *Royal*, U.S. Patent No. 5,383,293. It is the Examiner's position that *Royal* teaches a transparent plastic or glass panel. However, neither *Royal*, nor the combination of *Young* and *Royal*, teach or suggest positioning the glass as required by the Claims.

Claim 13, 14, 15 and 16 require that the front panel and rear panel have an electric light disposed between the front panel and the rear panel. The glass or plastic panel must be positioned opposite the imaged rear panel from the electric light. *Young* teaches away from placing any transparent material over the picture or image. *Royal* teaches a transparent or glass panel, but he provides no suggestion or motivation to one skilled in the art to position the glass or transparent material opposite the light bulb, from the image. One skilled in the

art, after reading the *Royal* reference, would position the transparent or glass material substantially adjacent to the picture or image, and not opposite the electric light. The combination of *Young* and *Royal* do not render Claims 13, 14, 15 or 16 obvious.

Claims 13-16 are particularly in condition for allowance, subject to being rewritten in independent form. Review and allowance at the earliest possible date is requested.

Respectfully submitted,



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Title: LIGHTED IMAGE DISPLAY

Examiner: Brian Green
Group Art Unit: 3611



CERTIFICATE OF MAILING

I hereby certify that this Response to Office Action Dated May 10, 2005, and Post Card are being deposited with the United States Postal Service, with sufficient postage attached thereto, in an envelope addressed to: Mail Stop AF, Commissioner For Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 11th day of July, 2005.

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